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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,861	12/14/2001	Werner Scheler	2267.547US03	6730
24113	7590	05/09/2006	EXAMINER	
PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.			ESTREMSKY, GARY WAYNE	
4800 IDS CENTER			ART UNIT	
80 SOUTH 8TH STREET			PAPER NUMBER	
MINNEAPOLIS, MN 55402-2100			3676	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,861

Applicant(s)

SCHELER ET AL.

Examiner

Gary Estremesky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9, 10 and 12-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5, 6, 9, 10, 12-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Reissue Applications

1. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed.

See 37 CFR 1.178.

2. Claims 5, 6, 9, 10, and 12-25 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The non-Final Office Action (Paper No. 13) rejected claims under 35 USC 102(b) in view of U.S.P.N. 3,421,471 to Richter, including examiners statement

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that claimed container door's "spaced walls" did not patentably define from the perpendicularly-arranged walls of the reference's container door and otherwise indicating claim limitations being anticipated by the prior art. In response to that rejection, the independent claim 9 was amended to include terminology of "and parallel" to further define the container door's walls' arrangement:

"a container door fitted in said container and comprising two walls, spaced apart from and parallel to each other".

Applicant's arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art : see page 4 of Applicant's response (Paper No. 15) filed June 25, 1999.

The claim was additionally amended at that time to specifically require that the claimed means for locking and unlocking the claimed container door was located between the two "parallel" walls:

"means for locking and unlocking said container door comprising locking elements provided within said container door between said two parallel walls and being displaceable into a moved-in position and into a moved-out end position and, when moving out, penetrates into said recesses within the container walls".

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Applicant's arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art : see page 4 of Applicant's response (Paper No. 15) filed June 25, 1999.

The claim was additionally amended at that time to specifically require specific structural arrangement of claimed locking elements, plates, rotatable disk, and motor:

"every locking element being in the form of a projection from a plate which is directed parallel to the outwardly directed wall of said container door, wherein all plates share a common drive in form of a rotatable disk driven by a motor and acting in the locking and unlocking direction for connecting rods provided for displacing the plates, the plates being fixed in the moved-in end position and in the moved-out end position by said connecting rods".

Applicant's arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art : see page 4-5 of Applicant's response (Paper No. 15) filed June 25, 1999.

The claim was additionally amended at that time to specifically require other structural features of the "means for providing a curved path" including particulars of that claimed element including its arrangement as regards each of the plurality of plate structures and couplers:

"said means for providing for providing a curved path further comprising structure to maintain and move every [locking element] plate parallel to an outwardly directed wall of said two parallel walls of the container door [and includes] by means of couplers, said couplers for every plate being [connected thereto which are] parallel to each other and [which are] rotatably [supported at the locking element] connected to said plate and also to said outwardly directed wall so that, as a result of the couplers, there is a predetermined distance between [the locking element] every plate and said outwardly directed wall in the moved-in state, which distance decreases during the outward movement until the locking element comes into contact with a contact surface in the recess against which the locking element is pressed in its moved-out end position".

Applicant's arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art : see page 5 of Applicant's response (Paper No. 15) filed June 25, 1999.

Page 6 of Applicant's arguments filed with that amendment (Paper No. 15) of June 25, 1999, indicates that Applicant also relies on the above amendments and each of the specific arguments to overcome the other prior art rejections including rejection under 35 USC 103 in view of Richter '471 and additionally Richter '471 in view of U.S.P.N. 1,929,341 to Wegner. As applied against the 35 USC 102 rejections and again against the 35 USC 103 rejections, the arguments

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relating allowability to each amendment are specifically stated in Applicant's Remarks.

Consequently, the claim(s) was allowed including statement by the examiner that it was the combination of all claim limitations that could not be re-constructed for purpose of prior art rejection less improper use of hindsight, essentially in agreement with Applicant's arguments and conclusion as to teachings of the prior art and allowability of the claim(s) at hand.

Inasmuch as the above-indicated limitations are a result of amendment specifically directed at overcoming prior art rejections, as indicated by Applicant's arguments relating the subject matter of the amendments to the allowability of the invention, that subject matter has been surrendered.

Claims 5, 6, 9, 10, 12-25 do not include all of the above limitations added and relied upon in arguments during Prosecution of the parent and are in effect, broadened in that respect. They do not include the subject matter which was surrendered in the original application in order to obtain the Patent. However, a reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

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Only claims including surrendered subject matter are proper for reissue.

See MPEP 1412.

Allowable Subject Matter

3. Claims 1-4 are allowed.

Response to Arguments

4. Applicant's arguments filed 11/17/05 have been fully considered but they are not persuasive.

MPEP 1412 describes the surrender of claimed subject matter at length and should be referenced appropriate as part of a response to this Office Action. See MPEP 1412.01 "THREE STEP TEST FOR RECAPTURE". It is the examiner's position that the rejected claims omit *surrendered* ("parallel", as one example) limitations as detailed above and are not proper for reissue. It's noted that this reissue Application was declared necessary in order to correct for Applicant's misunderstanding of how 'means for' limitations are properly interpreted as detailed in the MPEP 2181-2185. It's not particularly clear how deletion of limitations (other than 'means for' limitations) that were specifically added and argued to overcome prior art rejection is consistent with that declaration. Where "motor" limitation among other limitations was added by amendment and argued to define from prior art rejection and subsequently allowed, the "motor" limitation is surrendered and subject to the recapture rule. To some extent, it appears that this reissue Application specifically seeks additional examination of a scope of

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claim not including limitations surrendered during prosecution of the Application since considerably more subject matter than can be attributed to Applicant's misunderstanding of proper claim interpretation of 'means for' limitations is being pursued.

Regardless, the central issue appears to be whether limitations added and argued to overcome prior art and then allowed as a result of that amendment and argument are subject to a recapture rule. In that regard, it is the examiner's position that should an element be added by amendment and argued to overcome prior art rejection and the claim allowed, that element, at least in a broad sense, is subject to the recapture rule. Similarly, where a relationship between claimed elements is more specifically defined by an amendment and argued to overcome prior art rejection and the claim is subsequently allowed, that limitation is subject to the recapture rule. It is examiner's position that this reissue Application presents claims that entirely remove limitations defining elements and/or their interrelationship that were added by amendment and argued to overcome prior art and were subsequently allowed as a result of those amendments and arguments and are therefore subject to the recapture rule.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 571 272-7055. The examiner can normally be reached on M-Thur 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary Estremsky
Primary Examiner
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